

REMARKS/ARGUMENTS

Claims 1 and 6-24 are pending, claims 11-24 having been withdrawn from consideration. By this Amendment, claims 2-5 are cancelled without prejudice or disclaimer, and claims 1, 6-8, 19 and 20 are amended. Support for the amendments to claims 1, 6-8, 19 and 20 can be found, for example, in previously presented claims 1-8, 19 and 20. No new matter is added. In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

Withdrawn Claims

For the reasons set forth below, Applicants submit that all pending claims presently subject to examination are in condition for allowance. Because withdrawn claims depend from, and thus recite all features of, allowable claims subject to examination, rejoinder and allowance of the withdrawn claims are respectfully requested.

Objection to the Claims

The Office Action objects to claim 1. By this Amendment, claim 1 is amended to obviate the objection. Accordingly, reconsideration and withdrawal of the objection are respectfully requested.

Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 1-10 under the written description requirement of 35 U.S.C. §112, first paragraph. By this Amendment, claims 2-5 are cancelled, rendering the rejection moot as to those claims. Although Applicants disagree with the rejection and reserve the right to seek protection for the previously claimed subject matter at a later time,

by this Amendment, claims 1 and 6-8 are amended to obviate the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 6 and 7 as indefinite under 35 U.S.C. §112, second paragraph. By this Amendment, claims 6 and 7 are amended to obviate the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejections Under 35 U.S.C. §103

A. Nanavati and Wyman

The Office Action rejects claims 1-5 and 8-10 under 35 U.S.C. §103(a) over WO 01/66655 to Nanavati ("Nanavati") in view of U.S. Patent No. 5,077,135 to Wyman ("Wyman"). By this Amendment, claims 2-5 are cancelled, rendering the rejection moot as to those claims. As to the remaining claims, Applicants respectfully traverse the rejection.

Claim 1 is set forth above. Nanavati and Wyman do not disclose or suggest such a composition.

Applicants submit that the arguments set forth in the previous response are applicable to the present claims – more so, in view of the amendments to claim 1 to recite the combination of features in previous claims 1-5.

The Office Action asserts that it would have been obvious to employ the vinyl triethoxy silane of Wyman into the Nanavati because the coating of Wyman is smooth and uniform. *See* Office Action, page 14. However, the Office Action fails to explain how the vinyl triethoxy silane contributes to the smoothness and uniformity of the coating of Wyman or why one of ordinary skill in the art would reasonably expect that such vinyl triethoxy

silane could be successfully incorporated into the different combination of components in Nanavati.

Likewise, the Office Action asserts that it would have been obvious to employ the pyrogallol of Nanavati into the coating Wyman because the coating of Nanavati has unique physical characteristics. *See* Office Action, page 14. However, the Office Action again fails to explain how the pyrogallol contributes to the unique physical characteristics of the coating of Nanavati or why one of ordinary skill in the art would reasonably expect that such pyrogallol could be successfully incorporated into the different combination of components in Wyman.

The Office Action apparently takes the view that it would have been obvious to make any combination of components that have previously been used in barrier layers, merely because they have previously been used in barrier layers. This, however, is not the law of obviousness. *See, e.g., Ex parte Whalen*, 89 USPQ2d 1078, 1084 (Bd. Pat. App. & Int. 2008) ("[t]he *KSR* Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some 'apparent reason to combine the known elements in the fashion claimed'").

With respect to the molar ratio in claim 1, the Office Action asserts that "one of ordinary skill in the art would be motivated by common sense to select a 1:1 ratio." *See* Office Action, page 15. Applicants submit that the Office Action has provided no basis for this allegation of what would constitute "common sense." A martini includes gin and vermouth, but employing such ingredients in a 1:1 ratio can hardly be considered common sense.

In the absence of such "common sense," a molar ratio of at least one organoalkoxysilane to at least one aminoalkylalkoxysilane to at least one polyol must first be

recognized as a result-effective variable before the determination of workable ranges can be said to be an obvious variation. *See, e.g.*, MPEP §2144.05.II.B (citing *In re Antonie*, 195 U.S.P.Q. 6 (C.C.P.A. 1977)). The Office Action fails to identify, in any of the cited references, recognition that the molar ratio in claim 1 is a result-effective variable.

Any alleged *prima facie* of obviousness is rebutted by the results shown in the present specification – "[a] *prima facie* case of obviousness ... is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties." *See* MPEP §2144.09 (citing *In re Papesch*, 315 F.2d 381 (C.C.P.A. 1963)). The Examples of the present specification demonstrate that compositions that do not include each of components (i), (ii) and (ii) (Comparative Example 1) or that do not include components (i), (ii) and (ii) in the molar ratio required in claim 1 (Comparative Example 2) result in barrier layers with inferior oxygen permeation to barrier layers formed from compositions according to claim 1. *See, e.g.*, present specification, pages 10 to 15. These results are objective evidence of the improvements of the composition of claim 1 over known compositions as in Nanavati and Wyman, and thus these results rebut any suggestion that it would have been obvious to combine the teachings of Nanavati and Wyman as proposed in the Office Action.

As explained, claim 1 would not have been rendered obvious by Nanavati and Wyman. Claims 8-10 depend from claim 1 and, thus, also would not have been rendered obvious by Nanavati and Wyman. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

B. Nanavati, Wyman, Ichikawa and Komada

The Office Action rejects claim 6 under 35 U.S.C. §103(a) over Nanavati in view of Wyman, U.S. Patent No. 4,735,832 to Ichikawa et al. ("Ichikawa") and U.S. Patent

Application Publication No. US 2001/0038894 to Komada ("Komada"). Applicants respectfully traverse the rejection.

For the reasons discussed above, Nanavati and Wyman fail to disclose or suggest each and every feature of claim 1. Ichikawa and Komada fail to remedy the deficiencies of Nanavati and Wyman. Ichikawa is cited for its alleged disclosure of a barrier layer having low permeability to oxygen and carbon dioxide. *See* Office Action, page 7. Komada is cited for its alleged disclosure of a gas barrier film including tetraethoxysilane. *See* Office Action, page 8. However, Ichikawa and Komada, like Nanavati and Wyman, fail to disclose or suggest a composition including components (i), (ii) and (ii) in the molar ratio required in claim 1. Accordingly, the combination of references fails to disclose or suggest each and every feature of claim 1.

As explained, claim 1 would not have been rendered obvious by Nanavati, Wyman, Ichikawa and Komada. Claim 6 depends from claim 1 and, thus, also would not have been rendered obvious by Nanavati, Wyman, Ichikawa and Komada. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

C. Nanavati, Wyman and Huffer

The Office Action rejects claim 7 under 35 U.S.C. §103(a) over Nanavati in view of Wyman and U.S. Patent Application Publication No. US 2002/0146525 to Huffer et al. ("Huffer"). Applicants respectfully traverse the rejection.

For the reasons discussed above, Nanavati and Wyman fail to disclose or suggest each and every feature of claim 1. Huffer fails to remedy the deficiencies of Nanavati and Wyman. Huffer is cited for its alleged disclosure of a barrier coating including aluminum oxide. *See* Office Action, page 8. However, Huffer, like Nanavati and Wyman, fails to disclose or suggest a composition including components (i), (ii) and (ii) in the molar ratio

required in claim 1. Accordingly, the combination of references fails to disclose or suggest each and every feature of claim 1.

As explained, claim 1 would not have been rendered obvious by Nanavati, Wyman and Huffer. Claim 7 depends from claim 1 and, thus, also would not have been rendered obvious by Nanavati, Wyman and Huffer. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

D. Wyman and Nanavati

The Office Action rejects claims 1-5 and 8-10 under 35 U.S.C. §103(a) over Wyman in view of Nanavati. By this Amendment, claims 2-5 are cancelled, rendering the rejection moot as to those claims. As to the remaining claims, Applicants respectfully traverse the rejection.

For the reasons discussed above, Nanavati and Wyman fail to disclose or suggest each and every feature of claim 1.

As explained, claim 1 would not have been rendered obvious by Wyman and Nanavati. Claims 8-10 depend from claim 1 and, thus, also would not have been rendered obvious by Wyman and Nanavati. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

E. Wyman, Nanavati, Ichikawa and Komada

The Office Action rejects claim 6 under 35 U.S.C. §103(a) over Wyman in view of Nanavati, U.S. Patent No. 4,735,832 to Ichikawa et al. ("Ichikawa") and U.S. Patent Application Publication No. US 2001/0038894 to Komada ("Komada"). Applicants respectfully traverse the rejection.

For the reasons discussed above, Wyman, Nanavati, Ichikawa and Komada fail to disclose or suggest each and every feature of claim 1.

As explained, claim 1 would not have been rendered obvious by Wyman, Nanavati, Ichikawa and Komada. Claim 6 depends from claim 1 and, thus, also would not have been rendered obvious by Wyman, Nanavati, Ichikawa and Komada. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

F. Wyman, Nanavati and Huffer

The Office Action rejects claim 7 under 35 U.S.C. §103(a) over Wyman in view of Nanavati and U.S. Patent Application Publication No. US 2002/0146525 to Huffer et al. ("Huffer"). Applicants respectfully traverse the rejection.

For the reasons discussed above, Wyman, Nanavati and Huffer fail to disclose or suggest each and every feature of claim 1.

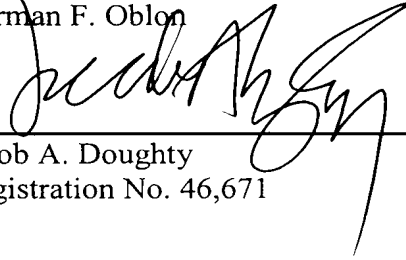
As explained, claim 1 would not have been rendered obvious by Wyman, Nanavati and Huffer. Claim 7 depends from claim 1 and, thus, also would not have been rendered obvious by Wyman, Nanavati and Huffer. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

For the foregoing reasons, Applicants submit that claims 1 and 6-24 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

A handwritten signature in black ink, appearing to read 'Jacob A. Doughty', is written over a horizontal line.

Jacob A. Doughty
Registration No. 46,671

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)